

1145  
PATENT

Case Docket No. UC083.001CP2

Date: May 23, 2002



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : TSIEN et al.  
Appln. No. : 09 866,538  
Filed : May 24, 2001  
For : NON-OLIGOMERIZING  
FLUORESCENT PROTEINS  
Examiner : Unknown  
Art Unit : 1645

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to United States Patent and Trademark Office, PO Box 2327, Arlington VA 22202, on

May 23, 2002

(Date)

Ginger R. Dreger, Reg. No. 33,055

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MAY 23 2002

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TRANSMITTAL LETTER

UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 2327  
Arlington, VA 22202

Dear Sir:

Enclosed for filing in the above-identified application are:

- (X) Establishment of Right of Assignee to Take Action and Revocation and Power of Attorney.
- (X) Two copies of Recorded Assignment Documents stamped "COPY - DO NOT RECORD".
- (X) The Commissioner is hereby authorized to charge any additional fees that may be required, or credit any overpayment, to Account No. 11-1410.
- (X) Return prepaid postcard.

Ginger R. Dreger  
Registration No. 33,055  
Attorney of Record

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COPY  
To: REGISTRATION

PATENT  
Attorney Docket No.: REGEN1530-2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Tsien and Campbell  
Application No.: 09/866,538  
Filed: May 24, 2001  
Title: NON-OLIGOMERIZING TANDEM FLUORESCENT PROTEINS

Art Unit: 1645  
Examiner: Unassigned

TECH CENTER 1600/2900

JAN 16 2002

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**BOX ASSIGNMENT**

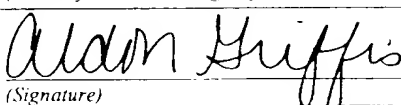
Director - U.S. Patent and Trademark Office  
Washington, D.C. 20231

**TRANSMITTAL SHEET**

Sir:

Transmitted herewith for the above-identified application, please find:

1. Two Recordation Form Cover Sheets and associated executed Assignments (3 pages and 5 pages, respectively);
2. Check Nos. 499218 and 499219 in the amount of \$40.00 each; and
3. Return Receipt Postcard.

CERTIFICATION UNDER 37 CFR §1.8	
I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on this date, <b>January 16, 2002</b> , in an envelope addressed to: Box ASSIGNMENT, Director, U.S. Patent and Trademark Office, Washington, D.C. 20231.	
<b>Aldon Griffis</b> (Name of Person Mailing Paper)	
 (Signature)	<b>January 16, 2002</b> (Date)

COPY

In re Application of:

Tsien and Campbell

Application No.: 09/866,538

Filed: May 24, 2001

Page 2

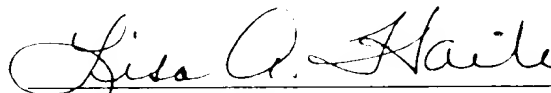
PATENT

Attorney Docket No.: REGEN1530-2

Enclosed are Check Nos. 499218 and 499219 in the amount of \$40.00 each for the Assignment Recordation Filing fees. The Commissioner is authorized to charge any other fees, or credit any overpayments, to Deposit Account No. 50-1355. A duplicate copy of this Transmittal Sheet is enclosed.

Respectfully submitted,

Date: January 16, 2002



Lisa A. Haile, J.D., Ph.D.

Registration No.: 38,347

Telephone: (858) 677-1456

Facsimile: (858) 677-1465

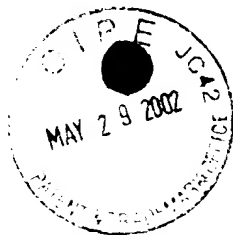
**USPTO CUSTOMER NUMBER 28213**

**GRAY CARY WARE & FREIDENRICH LLP**

4365 Executive Drive, Suite 1100

San Diego, California 92121-2133

UC083.001CP2



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : TSIEN et al. ) Art Unit: 1645  
App. No. : 09 866,538 )  
Filed : May 24, 2001 )  
Title : NON-OLIGOMERIZING TANDEM )  
FLUORESCENT PROTEINS )  
Examiner : Unknown )

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ESTABLISHMENT OF RIGHT OF ASSIGNEE TO TAKE ACTION  
AND  
REVOCATION AND POWER OF ATTORNEY

United States Patent and Trademark Office  
P.O. Box 2327  
Arlington, VA 22202

Dear Sir:

The undersigned is empowered to act on behalf of the assignee below (the "Assignee"). One of the two original Assignments of the above-captioned application is recorded at Reel 012585 and Frame 0458 from the inventor, Roger Y. Tsien, to the Assignee, HOWARD HUGHES MEDICAL INSTITUTE. The second original Assignment of the above-captioned application is recorded at Reel 012585 and Frame 0530 from the inventor, Roger Y. Tsien, acting as an agent for HOWARD HUGHES MEDICAL INSTITUTE, conveying all right, title and interest of HOWARD HUGHES MEDICAL INSTITUTE to the Assignee, THE REGENTS OF THE UNIVERSITY OF CALIFORNIA, and also from the inventor, Robert E. Campbell, to the Assignee, THE REGENTS OF THE UNIVERSITY OF CALIFORNIA, and an Agreement executed by Assignor, Robert E. Campbell is attached hereto. This Assignment represents the entire chain of title of this invention from the Inventor(s) to the Assignee.

App. No. : 09 866,538  
Filed : May 24, 2001

I declare that all statements made herein are true, and that all statements made upon information and belief are believed to be true, and further, that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that willful, false statements may jeopardize the validity of the application, or any patent issuing thereon.

The undersigned hereby revokes any previous powers of attorney in the subject application, and hereby appoints the registrants of Knobbe, Martens, Olson & Bear, LLP, 620 Newport Center Drive, Sixteenth Floor, Newport Beach, California 92660, Telephone (949) 760-0404, **Customer No. 20,995**, as its attorneys with full power of substitution and revocation to prosecute this application and to transact all business in the U.S. Patent and Trademark Office connected herewith. This appointment is to be to the exclusion of the inventor(s) and his attorney(s) in accordance with the provisions of 37 C.F.R. § 3.71.

Please use **Customer No. 20,995** for all communications.

CALIFORNIA THE REGENTS OF THE UNIVERSITY OF

Dated: May 21, 2002

By: Linda S. Stevenson  
Linda S. Stevenson

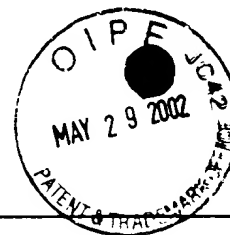
Title: Manager, Patent Prosecution

Address: 1111 Franklin Street, 5<sup>th</sup> Floor  
Oakland, California 94607-5200

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E. J. ...



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APRIL 15, 2002

PTAS

GRAY CARY WARE & FREIDENRICH LLP  
LISA A. HAILE  
4365 EXECUTIVE DRIVE, SUITE 1100  
SAN DIEGO, CA 92121-2133

Chief Information Officer  
Washington, DC 20231  
www.uspto.gov



\*101990171A\*

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 02/04/2002

REEL/FRAME: 012585/0530  
NUMBER OF PAGES: 5

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

CAMPBELL, ROBERT E.

DOC DATE: 08/24/2001

ASSIGNOR:

HOWARD HUGHES MEDICAL INSTITUTE

DOC DATE: 01/15/2002

ASSIGNEE:

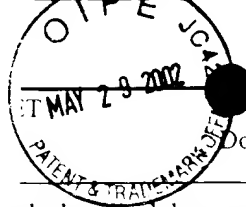
REGENTS OF THE UNIVERSITY OF  
CALIFORNIA, THE  
1111 FRANKLIN STREET, FIFTH FLOOR  
OAKLAND, CALIFORNIA 94607-5200

SERIAL NUMBER: 09866538  
PATENT NUMBER:

FILING DATE: 05/24/2001  
ISSUE DATE:

KIMBERLY WHITE, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

02-22-2002



Docket No.: REGEN1530-2

101990171

To the Honorable Commissioner for Patents and Trademarks. Please record the attached original documents or copy thereof.

## 1. Name of Conveying party(ies):

- a. Robert E. Campbell  
b. Howard Hughes Medical Institute

2-4-02

Additional name(s) of conveying party(ies)  
attached? ☐ Yes ☒ No

## 3. Nature of conveyance:

- ☒ Assignment ☐ Merger  
☐ Security Agreement ☐ Change of name  
☐ Other

Execution Date: a. August 24, 2001  
b. January 15, 2002

## 2. Name and address of receiving Party(ies)

Name: The Regents of the University of California

Internal Address: \_\_\_\_\_

Street Address: 1111 Franklin Street, Fifth FloorCity: Oakland State: CA Zip: 94607-5200Additional name(s) & address(es) attached?  
☐ Yes ☒ No

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JUN 03 2002

TECH CENTER 1600 2900

## 4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s)  
09/866,538

B. Patent No.(s)

FEB - 4 2002

Additional numbers attached? ☐ Yes ☒ No

## 5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Lisa A. Haile, J.D., Ph.D.  
GRAY CARY WARE & FREIDENRICH LLPStreet Address: 4365 Executive Drive, Suite 1100  
City: San Diego State: CA Zip: 92121-21336. Total number of Applications and patents involved: 17. Total fee (37 CFR 3.41) \$40.00

☒ Enclosed - Check No.: 499219  
☒ Authorized to charge any underpayment to  
Deposit Account No. 50-1355.

DO NOT USE THIS SPACE

## 9. Statement and signature:

*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.*

Lisa A. Haile, J.D., Ph.D.

Name of Person Signing

Registration No. 38,347

02/21/2002 LUELLER 00000040 09866538

01 FC:581

40.00 DP

Total number of pages including cover sheet, attachments, and document: 5

Signature

January 16, 2002

Date

ASSIGNMENT  
(BY INVENTOR(S))

This assignment ("Assignment") is made by Robert E. Campbell, of La Jolla, California, ("Assignors") to THE REGENTS OF THE UNIVERSITY OF CALIFORNIA, a non-profit organization ("Assignee"), having a place of business at 1111 Franklin Street, Fifth Floor, Oakland, California 94607-5200.

Recitals

A. Each of the Assignors has invented a new and useful invention entitled NON-OLIGOMERIZING TANDEM FLUORESCENT PROTEINS, for which an application for United States Letters Patent was filed on May 24, 2001 in the United States Patent and Trademark Office.

B. Each of the Assignors authorizes and requests insertion of the application serial number of the application when officially known:

The United States Application Serial No.: 09/866,538.

C. Each of the Assignors believes the Assignors to be the original, first and joint inventors of the invention disclosed and/or claimed in the application for Letters Patent.

D. The parties desire to have a recordable instrument assigning from the Assignors to the Assignee the entire rights, title and interest in and to the invention, the application and all Letters Patent in the United States and throughout the world that may be granted or issued for the invention or that derive a right of priority from the application (including, without limitation, all divisional, continuation, continuation-in-part and continued prosecution applications thereof, and all reissues and reexaminations thereof, and all foreign counterparts thereof) (collectively, the "Invention Patents").



Agreement

NOW, THEREFORE, in accordance with the obligations to assign the Invention Patents and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, each of the Assignors agrees to the foregoing and as follows:

1. Each of the Assignors does and will sell, assign and transfer to Assignee, such Assignor's entire rights, title, and interest in and to each of the Invention Patents, including, without limitation, the rights to file foreign applications directly in the name of the Assignee and to claim for any such foreign applications any priority rights to which such applications are entitled under international conventions, treaties, or otherwise.

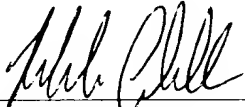
2. Each of the Assignors agrees that, upon request and without further compensation, but at no expense to such Assignor, such Assignor and such Assignor's legal representatives and assigns will do all lawful acts, including the execution of papers and the giving of testimony, that may be necessary or desirable for obtaining, sustaining, reissuing, or enforcing each of the Invention Patents in the United States and throughout the world, and for perfecting, recording, or maintaining the title of Assignee, and Assignee's successors and assigns, in and to each of the Invention Patents in the United States and throughout the world. In the event that Assignee is unable for any reason to secure any of the Assignors' signatures to any document that may be necessary or desirable for obtaining, sustaining, reissuing, or enforcing each of the Invention Patents in the United States and throughout the world, or for perfecting, recording, or maintaining the title of Assignee, and Assignee's successors and assigns, in and to each of the Invention Patents in the United States and throughout the world, each such Assignor hereby irrevocably designates and appoints Assignee and Assignee's duly authorized officers and agents as such Assignor's agents and attorneys-in-fact to act for and on such Assignor's behalf and instead of such Assignor to execute such document, all with the same legal force and effect as if executed by such Assignor.

3. Each of the Assignors represents and warrants that such Assignor has not granted and will not grant to others either (1) any rights, title or interest in and to any of the Invention Patents, or (2) any rights inconsistent with the rights granted herein.

4. Each of the Assignors authorizes and requests the Assistant Commissioner for Patents of the United States and the various counterparts thereof throughout the world to issue and/or grant any Letters Patent granted for each of the Invention Patents to Assignee, its successors and assigns, as the assignee of the entire interest in such Invention Patents.

5. This Assignment constitutes the entire agreement with respect to its subject matter and supersedes all prior or contemporaneous oral or written agreements concerning such subject matter. No waiver, amendment, or modification of this Assignment shall be effective against the Assignee, unless in writing executed by a duly authorized representative of the Assignee. This Assignment shall be governed in all respects by the laws of the United States of America and by the laws of the state/province of California, as such laws are applied to agreements entered into and to be performed entirely within California between California residents. Each of the parties irrevocably consents to the exclusive personal jurisdiction of the federal and state courts located in California, as applicable, for any matter arising out of or relating to this Assignment, except that in any action seeking to enforce any order or any judgment of such federal or state courts located in California, such personal jurisdiction shall be nonexclusive. A breach of any of the promises or agreements contained herein will result in irreparable and continuing damage to Assignee for which there will be no adequate remedy at law, and Assignee shall be entitled to injunctive relief and/or a decree of specific performance, and such other relief as may be proper.

Dated: Aug 24, 2001

  
\_\_\_\_\_  
Robert E. Campbell

ASSIGNMENTU.C. Case No. 2001-447-1

WHEREAS, I am acting as the agent for Howard Hughes Medical Institute ("HHMI") having an address at 4000 Jones Bridge Road, Chevy Chase, Maryland 20815 in conveying all right, title and interest of HHMI:

For good and valuable consideration, the receipt of which is hereby acknowledged, ASSIGNOR,

Roger Y. Tsien

hereby sells, assigns, and transfers to ASSIGNEE, the Regents of the University of California, a California Corporation, having its statewide administration offices located at 1111 Franklin Street, 5<sup>th</sup> Floor, Oakland, CA 94607-5200, and the successors, assigns and legal representatives of the ASSIGNEE all of its right, title and interest for the United States and its territorial possessions and in all foreign countries in and to, any and all improvements in the invention entitled:

NON-OLIGOMERIZING TANDEM FLUORESCENT PROTEINS

and which is found in

- (a) \_\_\_\_\_ U.S. patent application executed on \_\_\_\_\_, entitled as above and listing the above named person as inventor
- (b)   X   U.S. patent application serial no. 09/866,538, filed on May 24, 2001
- (c) \_\_\_\_\_ U.S. Patent No.: \_\_\_\_\_, issued \_\_\_\_\_

and any legal equivalent thereof in a foreign country, including the right to claim priority and, in and to, all Letters Patent to be obtained for said invention by the above application or in any continuation, divisional, continuation-in-part, extension or substitute thereof, and any reissue, reexamination or extension of said Letters Patent and all rights under all International Conventions for the Protection of Industrial Property;

ASSIGNOR(S) hereby covenants that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment;

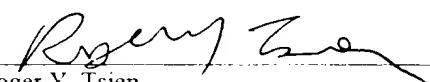
ASSIGNOR(S) further covenants that ASSIGNEE will, upon its request, be provided promptly with all pertinent facts and documents relating to said invention and said Letters Patent and legal equivalents as may be known and accessible to ASSIGNOR and will testify as to the same in any interference, litigation, or proceeding relating thereto and will promptly execute and deliver to ASSIGNEE or its legal representative any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue or enforce said application, said invention and said Letters Patent and said equivalents thereof which may be necessary or desirable to carry out the purposes thereof. An attorney of record is authorized and requested by the execution of this assignment to insert into this assignment the filing date and serial number of said application when officially known.

AND the ASSIGNOR(S) requests the Commissioner of Patents and Trademarks to issue said Letters Patent of the United States and any reissue or extension thereof to the ASSIGNEE, The Regents of the University of California.

executed this

Signature of Inventor(s)

15th day of January, 2002

  
Roger Y. Tsien